

## **REMARKS**

The Office Action mailed May 17, 2006 considered claims 1-10, 24, 42, 43, and 45-51. Claims 1, 42, 43 were objected to for various informalities. Claims 1-10, 24, 42, 51 were rejected under 35 U.S.C. 101 because the office action asserts that the claimed invention is directed to non-statutory subject matter. Claims 1, 3, 10, 24, 42, 45, 51 were rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 1-4, 10, 24, 42, 51 were rejected under 35 U.S.C. 103(a) as being unpatentable over *De Meno*, et al. (US 6,721,767) hereinafter *De Meno* in view of *Traversat*, et al. (US 6,161,125) hereinafter *Traversat*. Claims 5-9, 43, 45-50 were rejected under 35 U.S.C. 103(a) as being unpatentable over *De Meno* in view of *Traversat* and further in view of *Hammack* et al. (US 6,449,624) hereinafter *Hammack*.<sup>1</sup>

By this amendment, claims 1, 3, 10, 24, 42, 43, and 51 have been amended and claims 1-10, 24, 42, 43, and 45-51 remain pending in the application.

### **Claim Objections**

With regard to the claims objections, applicants have amended the claims to reflect the Examiner's suggested claim language.

### **Rejections under 35 U.S.C. 101**

With regard to the rejections under 35 U.S.C. 101, applicants have amended the claims to obviate the Examiner's rejections. However, applicants do not necessarily agree with the Examiner's rejections and reserve the right to present additional arguments regarding the patentability of the claims as written prior to the amendments to address the Examiner's 35 U.S.C. 101 concerns. In particular, the Examiner rejected claims 1 and 42 as being directed to non-statutory subject matter for not reciting that the method is implemented on a computer system. The Examiner's attention is directed to the Board of Patent Appeals and Interferences

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<sup>1</sup> Although the prior art status of the cited art is not being challenged at this time, Applicant reserves the right to challenge the prior art status of the cited art at any appropriate time, should it arise. Accordingly, any arguments and amendments made herein should not be construed as acquiescing to any prior art status of the cited art.

precedential opinion styled *Ex parte Carl A. Lundgren*. In *Lundgren*, the board rejected the "technological arts" test as a test for determining validity of subject matter under §101. See page 7. The United States Patent and Trademark Office has, subsequent to the *Lundgren* decision, issued "Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility." These guidelines, and particularly at Annex III of the guidelines, make clear that a claim may not be rejected simply because a method is not necessarily implemented by a machine.

Further, with respect to claims 2-10, 24, and 51, which were rejected for including computer readable media including wireless signals, applicants note that claims 2-10 do not recite computer readable media. As such, the Examiner's rejection is specifically traversed with respect to these claims. With respect to claims 24 and 51, applicants disagree with the Examiner's assertion that the specification does not disclose tangible computer readable media and as such, traverse the Examiner's rejection to claims 24 and 51. Figure 1 of the application illustrates several examples of what can be characterized as "tangible computer readable media" including system memory 522, a hard drive 539, a floppy disk 529, a CD or DVD 531, etc. Simply because the term "tangible computer readable media" has not been used in the specification does not mean that it is not disclosed and enabled in the filed application. The written description is satisfied when the patent specification, including any originally filed claims, "describe the claimed invention in sufficient detail that one skilled in the art can reasonably conclude that the inventor had possession of the claimed invention." *Moba, B.V. v. Diamond Automation, Inc.*, 325 F.3d 1306, 1319, 66 U.S.P.Q.2d (BNA) 1429, 1438; *see also* M.P.E.P. § 2163(I). Moreover, support for the claim limitations may be express, implied, or inherent. M.P.E.P. § 2163(I)(B). Applicants submit that the claims are supported by the specification as understood by one of ordinary skill in the art. The specification and claims as originally filed support the use of tangible computer readable media.

### **Rejections Under 35 U.S.C. 112**

Various claims were rejected under 35 U.S.C. 112 for various antecedent basis issues and understandability issues. For the most part, applicants have amended the claims to obviate the Examiner's rejection. Please note however, that the claims were not always amended to comport

with the Examiner's assumptions. For Example, at line 21 of claim 1 (and similarly in claims 23, 42 and 51), the Examiner assumed "it" to refer to "the stored package." However, this is not what was intended, and as such appropriate amendments have been made to further clarify. Specifically, the claims have been amended from "retrieving the stored package when it is desired to" to "retrieving the stored package when desirable to...." With respect to claim 3, claim 3 now depends from claim 2 where sufficient antecedent basis for the routine can be found.

With respect to claim 45, applicants traverse the Examiner's rejection. The Examiner asserts that "Claim 45 recites the header portion, which is data about the package, is enabled to call a reversion routine; it is not possible for data about something to actually do something. Header data is not operative, although it can contain pointers to functions or other operations." However, the claim 45 specifically recites "wherein the header portion further comprises a call to a reversion routine." "Call" in this context is clearly a noun as illustrated by the article "a" preceding call. It is well known that articles point to nouns and not verbs. In fact, articles are often considered by many grammarians to be adjectives (as opposed to adverbs). The Microsoft Computer Dictionary 4<sup>th</sup> ed. defines the noun "call" thusly: "*n.* In a program, an instruction or statement that transfers program execution to some section of code, such as a subroutine, to perform a specific task." Thus, the usage of "call" in claim 45 is entirely proper.

### **Rejections Under 35 U.S.C. 103**

Claims 1-4, 10, 24, 42, 51 were rejected under 35 U.S.C. 103(a) as being unpatentable over *De Meno* in view of *Traversat*. Applicants respectfully traverse this rejection. In particular, as will be illustrated in more detail below, the Examiner has not met the duty of presenting a *prima facie* case of obviousness.

In the claims of the present application, claims 1 and 42 (directed to a method) and 24 and 52 (directed to a computer program product for the method), applicant has defined a method of reverting a current configuration setting for a software application to a previous *configuration setting* so that the software application will be capable of operating on data in the same manner as it did with the previous configuration settings that were used by the application software.

Based upon a request from a user or a selection from the software application, the method first requires generating changes to the software application's configuration settings. A configuration store is then updated by storing therein the changed application configuration settings of the software application to maintain a history of one or more configuration setting changes for the software application. Next, a package is generated that uniquely identifies the contents of the package and the changes to the software application's configuration settings so that the package can be later recalled and used when reverting the configuration settings of the software application back to a state that existed prior to the changes in the configuration settings. The package is then stored in a software application configuration log, from which it is later retrieved when it is desired to revert the configuration settings of the software application back to a state that existed prior to the changes in the configuration settings so that the software application will be capable of operating on data in the same manner as it did with the previous configuration settings that were used by the application software.. Finally, the contents of the package are used to revert the configuration settings back to those that existed prior to the changes identified by the package so the software application will thereafter be capable of operating on data in the same manner as it did prior to such changes. Id.

Clearly, *De Meno* et al.'s rollback module refers to rolling back data operated on by an application and not configuration settings which define how an application will operate on data, as contrasted to applicant's recited claims. In particular, *De Meno* discloses an application specific rollback "module with an index for assisting in locating different stats of the application specific *data* that were generated by the user requests. Also included...is a logical view storage that provides an organizational scheme for storage of the application specific data on one of a plurality of storage media, for migration of the...*data* to other ones of the plurality of storage media, for tracking the migration of the...*data* over time, and for maintaining the index...." Abstract. The Examiner further admits in the present office action at page 13 line 9 that *De Meno* does not disclose "configuration settings." To compensate for the deficiencies of *De Meno*, the Examiner cites *Traversat* as showing configuration settings. However, such a combination is clearly improper hindsight reconstruction, and in any case is not sufficient to sustain a *prima facie* case of obviousness. In particular, MPEP 2143.01 VI notes that "[i]f the proposed modification or combination of the prior art would change the principle of operation of

the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious.” (citing *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959)). “In *Ratti*, claims were directed to an oil seal comprising a bore engaging portion with outwardly biased resilient spring fingers inserted in a resilient sealing member. The primary reference relied upon in a rejection based on a combination of references disclosed an oil seal wherein the bore engaging portion was reinforced by a cylindrical sheet metal casing. Patentee taught the device required rigidity for operation, whereas the claimed invention required resiliency.” *Id.* This is exactly analogous to the present case where the Examiner is trying to substitute data operated on by an application for configuration settings defining how data is operated on by an application. By substituting configuration setting for data that is actually operated on, the Examiner has changed the principle of operation of the prior art invention. Specifically, the invention of *De Meno* is no longer a system for recovering data operated on by an application, but rather a system for recovering configuration settings, if modified in the way suggested by the Examiner. As such, *De Meno* cannot be modified as suggested by the Examiner to sustain a *prima facie* case of obviousness.

Additionally, the proposed modification would seem to make the system disclosed by *De Meno* unsuitable for its intended use. In particular, if configuration settings are substituted for data to be operated on, the system disclosed by *De Meno* is no longer suitable for recovering application data. MPEP 2143.01 V states that “[i]f proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification.” As such, the Examiner’s rejection simply cannot be maintained.

In view of the foregoing, Applicants respectfully submit that the other rejections to the claims are now moot and do not, therefore, need to be addressed individually at this time. It will be appreciated, however, that this should not be construed as Applicants acquiescing to any of the purported teachings or assertions made in the last action regarding the cited art or the pending application, including any official notice. Instead, Applicants reserve the right to challenge any of the purported teachings or assertions made in the last action at any appropriate time in the future, should the need arise. Furthermore, to the extent that the Examiner has relied on any

Official Notice, explicitly or implicitly, Applicants specifically request that the Examiner provide references supporting the teachings officially noticed, as well as the required motivation or suggestion to combine the relied upon notice with the other art of record.

In the event that the Examiner finds remaining impediment to a prompt allowance of this application that may be clarified through a telephone interview, the Examiner is requested to contact the undersigned attorney.

Dated this 17<sup>th</sup> day of July, 2006.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Rick D. Nydegger", written in a cursive style.

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